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RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re David McQuade Leibowitz

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Serial No. 75/151,245

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Daniel D. Chapman of Miller, Sisson, Chapman & Nash, P.C. for David McQuade Leibowitz.

Kimberly Krehely, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

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Before Cissel, Hanak and Holtzman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 18, 1996, applicant filed the above-referenced application to register the following phrase

_____ GRAD _____DAD, THE BEST OF BOTH WORLDS

on the Principal Register for "bumper stickers," in Class 16, and for "clothing, and hats," in Class 25. Applicant stated in the application that "[t]he blanks are intended to be filled in with the nickname of a college, such as

'IRISH GRAD' and 'AGGIE DAD' or 'LONGHORN GRAD' and 'SOONER DAD.'" The basis for filing the application was applicant's assertion that he possesses a bona fide intention to use the mark in commerce in connection with the specified products.

The Examining Attorney refused registration, stating that what applicant is attempting to register is a phantom mark, i.e., a mark which includes words which are subject to change, and that such marks are not registrable because registration of them would deny third parties fair notice, in that it would be impossible to conduct a meaningful search without specific knowledge of each possible permutation in view of the unspecified word elements represented by the blanks in the drawing of the mark submitted with the application. Applicant was also informed that the identification-of-goods clause for Class 25 was indefinite and that the application should be amended to specify the particular items of clothing with which the phrase is intended to be used as a trademark.

Responsive to the first Office Action, applicant amended the clause identifying the goods in Class 25 to read as follows: "clothing, namely shirts, hats, and jackets." Applicant requested that the following statement be entered into the application by amendment: "Applicant

herewith disclaims the nicknames of any colleges intended to be placed in the blanks of applicant's mark." Applicant also presented arguments on the refusal to register, and submitted a copy of a third-party registration and photocopies from the Official Gazette of another third-party mark approved for publication. In each instance, applicant argued that if those marks were acceptable, so is his.

The Examining Attorney was not persuaded by applicant's arguments or evidence, and in the second Office Action, he made the refusal to register final. The amendment to the identification-of-goods clause was accepted, but the proposed disclaimer was not, on the ground that the proffered disclaimer does not specifically state what the words are in which applicant makes no claim to exclusive rights. Further, the Examining Attorney noted that as applied to bumper stickers, the proposed mark may not function as a mark, but that such a refusal could not be made until applicant provided evidence of actual use, at which time such a determination could be made.

Applicant filed a Notice of Appeal, along with a request for reconsideration presenting arguments as to why the refusal to register is not well taken. A substitute

drawing was also submitted. This drawing shows the proposed mark as follows:

SOONER GRAD AGGIE DAD,

THE BEST OF BOTH WORLDS

The lettering in which the words “SOONER’ and “AGGIE” are shown is presented in broken lines. Additionally, applicant requested that the disclaimer be amended to read “No claim is made to any of the matters shown in broken lines apart from the mark as shown.”

The Examining Attorney responded to the request for reconsideration and accompanying amendments by maintaining the finality of the refusal to register and rejecting both the substitute drawing and the substitute disclaimer. He held the amended drawing to be a mutilation of the one originally submitted with the application, creating a different mark by including the words “SOONER” and “AGGIE.” The reference in the proposed disclaimer with respect to “any matters shown in broken lines” was rejected for the same reason that the first disclaimer had been rejected: any terms or other matter being disclaimed must be specifically identified in the disclaimer.

Action on the appeal was then resumed. Applicant submitted his appeal brief, but the original Examining Attorney was replaced by another one, so action on the

appeal was again suspended, and the application was remanded to her for additional action on applicant's latest proposed amendments. She refused registration on additional grounds: under Section 2(a) of the Lanham Act on the ground that the mark shown in the amended drawing consists of or comprises matter which may falsely suggest a connection with the Board of Regents of the University of Oklahoma and Texas A&M University, the respective owners of the trademarks "SOONERS" and "AGGIES"; and also under Section 2(d) of the Act based on the likelihood of confusion with the marks in nine of the registrations these two educational institutions own.

In addition, the Examining Attorney advised applicant that she found the instant case to be indistinguishable from the one decided by the Board in In re International Flavors & Fragrances Inc., 47 USPQ2d 1314 (TTAB 1998), aff'd, 183 F.3d 1361, 51 USPQ 1513 (Fed. Cir. 1999). A copy of the Board's opinion was attached for applicant's consideration. In that case, the Examining Attorney had refused to register the marks "LIVING XXXX," "LIVING XXX FLAVORS" and "LIVING XXX FLAVOR" for essential oils and flavor substances. The applicant had stated that the "XXXX" in each mark stood for different words which are the names of specific herbs, fruits, plants or vegetables, and

that in use, the mark would incorporate these names in place of the "XXXX" shown in the drawing. The issue was framed in terms of whether the specimens submitted with the application showed the mark sought to be registered, as reflected by the drawing. The Board held that what applicant was trying to protect with the three registrations it was seeking was in fact an unknown number of marks, whereas Section 1 of the Lanham Act provides that each application may seek registration of only one mark. Notwithstanding the existence of third-party registrations which appeared to be in conflict with this holding, the refusal to register was affirmed.

The applicant in the appeal now before us responded to the action by the new Examining Attorney with a withdrawal of the amended drawing and a request that the appeal go forward based on the final refusal which had been issued previously. The Examining Attorney then withdrew the refusals to register under Sections 2(a) and 2(d), and noted that applicant had not amended the application to delete the disclaimer of "matters shown in broken lines," even though the drawing now of record has none.

In response, applicant withdrew the second disclaimer, but left the first one, which refers to "the nicknames of

any colleges intended to be placed in the blanks of applicant's mark."

The Examining Attorney then filed her brief on appeal. Applicant neither filed a reply brief nor requested an oral hearing before the Board.

Accordingly, the issues before the Board in this appeal are whether the phrase sought to be registered by this application, "_____GRAD_____DAD, THE BEST OF BOTH WORLDS," in consideration of applicant's statement that the blanks are intended to be filled in with nicknames of colleges, constitutes more than one mark, and therefore is contrary to the provisions of Section 1 of the Lanham Act; whether a substitute drawing is required in order to present a single mark; and whether the proffered disclaimer is acceptable in view of the fact that it does not specify the particular words that applicant asserts it is disclaiming. After careful consideration of the record, the arguments presented by both applicant and the Examining Attorney, as well as the relevant legal precedents on this issue, we hold that the refusal to register and the requirements for a substitute drawing and an acceptable disclaimer which specifies what is being disclaimed are all proper and must all be affirmed.

We agree with the Examining Attorney that the International Flavors case, supra, is directly on point with the case at hand. That "XXXX" was used there to represent the differing "phantom" elements in place of the underlining which is used in the case at hand is immaterial, as is the fact that the applicant in that case intended to use the names of herbs, fruits, plants or vegetables, whereas the applicant in this case uses the equally vague language "the nickname of a college" to describe the variety of words it intends to use to fill in the blanks in its mark as presented for registration by the drawing submitted with the application. As the Examining Attorney points out, both applicants attempted to add a disclaimer statement of the words represented by their respective "substitution vehicles," and both applicants argued that past inconsistent practice by the Patent and Trademark Office requires approval of marks containing changeable elements.

Just as in the prior case, however, these arguments are unavailing. As in that case, contrary to Section 1 of the Act, the instant application seeks registration of more than one mark, and as in that case, the instant application does not give adequate notice of what is being claimed as applicant's mark, such that a meaningful search by another

party trying to avoid choosing a mark which would be likely to cause confusion "is next to impossible." International Fragrances, supra, 47 USPQ2d at 1318. The refusal based on Section 1 of the Act is therefore well taken.

In a similar sense, just as a single application may not seek registration of more than one mark, there clearly cannot be more than one mark shown on the drawing submitted with a single application. Trademark Rule 2.51 requires submission of "the drawing" of what is repeatedly referred to as "the trademark," which is a clear indication that only one trademark may be represented in a single drawing. In that the drawing of record in the instant application clearly is intended to represent any number of different combinations of words, the requirement for a drawing showing only one mark is plainly appropriate.

Also, in a similar sense, the requirement for a disclaimer that refers to specific, identifiable words or other matter is justified. As it stands, the proffered disclaimer provides no indication of what applicant intends to disclaim, and we therefore have no basis upon which to determine whether whatever it is in which applicant claims no exclusive rights constitutes "an unregistrable component of a mark otherwise registrable," in the words of Section 6 of the Act.

DECISION: The drawing and disclaimer requirements and the refusal to register are affirmed.